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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,451	03/30/2004	J. Mark Morrow	031599/260277	3164

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EXAMINER

THAKUR, VIREN A

ART UNIT	PAPER NUMBER
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1794

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/812,451	Applicant(s) MORROW, J. MARK	
	Examiner Viren Thakur	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-21 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-21 and 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. As a result of the amendment, the rejection of claims 1, 10, 18, 20 and 21 under 35 U.S.C. 102(b) as being anticipated by Stewart (US 4909394) has been withdrawn.
2. As a result of the cancellation of claim 22, the rejection under 35 U.S.C. 112, second paragraph, has been withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. **Claims 1, 4-21 and 23-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Instant claim 1 recites the limitation "having a different configuration from the primary container." It is unclear from the claim as to what is meant by "a different configuration." The specification uses the term configuration to describe

the arrangement of the cup holder with respect to the primary container however this has already been described in the claim and as such the limitation "different configuration" is unclear.

5. **Claims 11 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claims 11 and 24, the phrase "such that" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. **Claims 1, 4-6, 10-11 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tai (US 6138862) in view of Stewart (US 4909394), Schnakenberg (US 1366839) and Rasanen (WO03068613).**

The limitations and reasons for rejection are taken as cited in the prior Office Action, mailed August 9, 2007.

The amendment to the claims brought the limitations of claim 2 in to claim 1, thus requiring the addition of the Rasanen reference.

It is additionally asserted regarding the rejections using Tai, Stewart and Schnakenberg, that Tai teach the use of a cup and a cup holder. Stewart teaches that it has been known in the art to provide a packaged configuration wherein a food product is disposed between a primary container and another container. Stewart is also relied on to teach using the two cups, such as those similar to Tai for providing a packaged beverage, wherein the two cups provide a seal between which is provided the food product. In combination Tai teaches using one of the cups as a cup holder to provide insulation, while Stewart teaches using the cup to seal the contents therein. Schnakenberg is relied on to similarly teach using two containers for sealing a dry beverage material therein and further for utilizing both containers for mixing when water is added to the dry mix. Nevertheless the prior art teaches using a cup for sealing a container that has a food product therein and also to use a nested cup for the purpose of heat insulation when the dry mix is hydrated.

Regarding the limitation wherein the cup holder has a different configuration from the primary container and in light of the rejection under 112, second paragraph, above, it is noted that Tai teach two containers having a different configuration. That is, the inside container is rotated 90 degrees relative to the outside container for the purpose of providing the insulating effect.

Additionally, it is noted that to shorten the cup holder as recited in instant claim 11, and thus change the configuration of the cup holder to be different from the configuration of the primary container would not have provided a patentable feature over the prior art. The physical length of the cup holder is considered a change in size which would not have resulted in the prior art performing any differently than the instantly claimed invention (See MPEP 2144.04 IV A), since it appears that the purpose of the length of the cup holder is to allow for the space into which the food product is disposed. Nevertheless, to shorten the length would have thus been a matter of design choice for one having ordinary skill in the art and as such to shorten the length of the cup holder would also have provided the cup holder with a different configuration than that of the primary container.

Therefore, applicant's concept of a packaged and serving configuration of a nested cup and cup holder has been taught or suggested by the prior art.

2. **Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tai, Stewart, Schnakenberg and Rasanen as applied to claims 1, 4-6,10-11 and**

18-21 above, and in further view of Holly (US 3246786) and Shelby (US 3374922).

The reference and reasons for rejection are taken as cited in the prior Office Action, mailed August 9, 2007.

- 3. Claims 7-9, 12-17, 24, 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tai in view of Stewart (US 4909394), Schnakenberg (US 1366839) and Rasanen (WO03068613), as applied to claims 1, 4-6, 10-11 and 18-21 above, and in further view of Muraoka (US 4018904). Sorensen (US 5425497) is cited as evidence.**

The references and reasons for rejection are taken as cited in the prior Office Action, mailed August 9, 2007.

- 4. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tai (US 6138862), Schnakenberg (US 1366839), Stewart (US 4909394), Rasanen (WO03068613) and Muraoka (US 4018904) as applied to claims 7-9, 14-17, 24, 25 and 27, above, and in further view of Candy (US 5938015).**

The references and reasons for rejection are taken as cited in the prior Office Action, mailed August 9, 2007.

5. **Claims 1, 4-10, 14-17, 19-21 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muraoka (US 4018904) in view of Stewart (US 4909394).**

The references and reasons for rejection are taken as cited in the prior Office Action, mailed August 9, 2007.

6. **Claims 11, 12, 18 and 27 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Muraoka (US 4018904) and Stewart (US 4909394), as applied to claims 1,4-10, 14-17, 19-21 and 23-25, above, and in further view of Syverson et al. (US 3227273).**

The references and reasons for rejection are taken as cited in the prior Office Action, mailed August 9, 2007.

Response to Arguments

7. Regarding the rejection of claims 11 and 24 under 35 U.S.C. 112, second paragraph, it is noted that as a result of the term, "such that" it is unclear as to whether the terms following the phrase are part of the claimed invention. It is noted that the cup must only have the limitations as disclosed, so that the container must only be capable of defining a space between a bottom wall, for instance. For this reason, the rejection is maintained for the reasons of record. Even if the language stated "as a result of which," as suggested by applicant, this

would still be considered functional language that the prior art would only be required to be capable of performing. Thus it is unclear as to whether the language following the limitation is part of the claimed invention.

8. On page 8 of the response, applicant states that Muraoka's container includes projections that engage a recess between the ribs in the packaged configuration only. If Muraoka's containers were reversed and placed in a serving configuration, as claimed, it would be impossible for the radially inwardly projecting projections to engage anything on the cup, which would then be radially outward of the cup and its projections. Applicant further states that the ribs projecting radially outwardly from the cup could not engage anything on the cup, which would then be radially inward of the cup and its ribs.

Applicant's arguments have been carefully considered but are not deemed persuasive. It is noted that instant claim 1 recites the wherein the cup holder is removable from the primary container such that the package can be converted into a serving configuration. Therefore, as previously stated, the package must only be capable of being reversed for the purpose of providing a serving configuration for the purpose of forming a double walled thermally insulating structure. Furthermore, the claim recites "complementary locking features on the cup holder and the primary container for locking the primary container into the cup holder in the serving configuration of the package..." Therefore, the package must only contain complementary locking features, as discussed in the prior

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Office Action, mailed August 9, 2007, and wherein the locking features are capable of locking the cup holder to the outside of the primary container, in a serving configuration. It is noted that the ribs (16 and 17) project outwardly when in the packaged configuration. When the cup holder and the primary container are reversed so that the cup holder is in the serving configuration it is noted that the ribs (16 and 17) also have inwardly projection portions (Items 13 and 14). These inwardly projection portions would have met with the primary containers portions (Items 6,8 and 10) for providing complementary locking in a serving configuration. Since the claims recite wherein the package must only be capable of being nested in a serving configuration, it is noted, that there would have been a reasonable expectation of success that the locking features, as discussed above, would have resulted in locking of the primary container within the cup holder.

Regarding applicant's assertion that there is nothing in Muraoka's disclosure indicating that if the cups were reversed in orientation that there would have been a snug fit between them it is noted that the reversing in orientation is merely a capability of the package, as currently claimed. And as discussed above, based on the skill of one having ordinary skill in the art, the package would have been capable of being reversed and there would have been a reasonable expectation of success in reversing the container. As previously discussed, the package must only be capable of being oriented in a serving configuration. This is further supported by the claim language, "the cup holder

being removable from the primary container *such that the package can be* converted into a serving configuration.

It is further noted that applicant is claiming a primary container and a cup holder with the cup holder nested in the primary container when the package is in a packaged configuration. The claim does not positively recite the packaged configuration but only states that the cup holder is nested, at the time that it is packaged, into the primary container.

9. On page 9 of the response, applicant states that Tai does not disclose locking features and fails to disclose the elongated skirt, flange and channel and further fails to disclose the channel receiving the rim of the primary container when the package is in the packaged configuration, as required by claim 1. As noted above, the packaged configuration is a future state of the package. That is, the package must only contain a primary container and a cup holder such that when the package is in a packaged configuration the channel of the cup holder receives the rim of the primary container. Regarding Schnakenberg, applicant similarly states that the reference lacks various features of claim 1, including at least the rim on the primary container, the flange and skirt on the cup holder, the complementary locking features and the channel receiving the rim of the primary container when the package is in the packaged configuration.

In response to applicant's arguments against these references individually, one cannot show nonobviousness by attacking references individually where the

rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case it has been recognized by the examiner that Tai, Stewart and Schnakenberg are silent in teaching wherein an elongated skirt depends from the flange of the cup holder such that a channel is defined between the skirt and the side wall of the cup holder, the channel of the cup holder being configured to receive the rim of the primary container when the package is in the packaged configuration. In combination with Rasanen however, the references teach the elements of the instant claim, as obvious, for the reasons of record.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 3541029, US 3717478, US 3743520, US 4074827 disclose a food product in a container that is nested within a main container. US 2766796 which has already been cited also discloses a food product in a container that is nested within a main container. It is noted that US 4348421, which has already been cited, also discloses nested containers wherein the food product is within either container. The food product is disclosed within the nested container and also within the main container. US 3598271 disclose two containers wherein a nested container covers the cup but also acts as a coaster or cup holder when removed.

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11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viren Thakur whose telephone number is (571)-272-6694. The examiner can normally be reached on Monday through Friday from 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571)272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Viren Thakur
Examiner
Art Unit: 1794

Steve Weinstein
STEVE WEINSTEIN
PRIMARY EXAMINER 1794

07/13/07